

REMARKS

The above amendments and these remarks are responsive to the Office action dated July 14, 2006. Claims 1-20 are pending in the application. Claims 1-20 are rejected. Claim 1 has been amended. In view of the above amendments and the following remarks, Applicants respectfully request reconsideration of the claims under 37 C.F.R. § 1.111.

Applicants thank the Examiner for consideration of the previously submitted information disclosure statement, and for acknowledgment of their priority claim under 35 U.S.C. § 119(e).

Rejections under 35 U.S.C. § 103

Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods (U.S. Patent no. 5,758,777; hereafter Dods '777) and Goldfarb et al. (U.S. Patent no. 6,306,470). In particular, the Examiner suggests that it would have been obvious to one of ordinary skill in the art to modify the panel of Dods to include a lithophane panel in order to create an image of extreme beauty and delicacy so as to be pleasing to an observer. Applicants respectfully suggest the Examiner has failed to establish the *prima facie* obviousness of the claimed invention.

Prima facie obviousness requires that there be some suggestion or motivation in the prior art itself to modify the reference or to combine reference teachings. The motivation to combine references may be found in the nature of the problem to be solved, the teachings of the prior art, or the knowledge of an ordinary skilled artisan, but the prior art *must* suggest the desirability of the claimed invention.

Goldfarb et al. fails to provide any suggestion to combine a lithophane with a toy figure. In fact, Goldfarb et al. fails to suggest the use of porcelain lithophanes entirely, as the reference is directed to apparatus that can be filled with a translucent material to display the characteristics

of a lithophane (see col. 2, lines 1-56). Goldfarb et al. does not mention toy figures, or toy figure packaging at all, and particularly fails to suggest the combination of a toy figure and a lithophane panel. In fact, Goldfarb et al. teaches that "the lithophane process is expensive and time consuming and requires substantial skill", whereas the apparatus of Goldfarb et al. may be readily filled to produce a desired lithophane effect. The disclosed apparatus are not lithophane panels, however. Applicants suggest that Goldfarb et al. fails to suggest the desirability of the combination of a lithophane panel and a toy figure.

The Dods '777 reference is directed to a package that includes a figurine in combination with a model book or magazine and a display stand. In particular, the Dods '777 packaging is intended to satisfy the interest of a comic book collector in a particular vintage comic book by reproducing it as a background for the figurine (see col. 1, line 36 to col. 2, line 24). However, Dods '777 fails to disclose lithophanes, and fails to suggest the desirability of their combination with the packaging of the Dods '777 figurine.

The Examiner has merely recited a property of lithophanes, namely that some lithophanes can provide "a picture of extreme beauty and delicacy", and asserted that this property by itself, independent of any other teaching, is sufficient to suggest the combination of a lithophane with a toy figure depicting a character in a toy set, as recited in claim 1. Applicants disagree. Although lithophanes have been known to produce sometimes striking images when viewed properly, the Examiner has failed to explain how the beauty of lithophanes translates into a suggestion to combine them with a toy figure.

Applicants suggest that the "extreme beauty and delicacy" of a lithophane exists independently of its combination with a toy figure, therefore providing no incentive for the combination. Similarly, if the beauty and delicacy of the lithophane alone provides sufficient

incentive to combine the lithophane with an unrelated object, then it necessarily provides sufficient motivation to combine *any* particularly beautiful object with any other unrelated object. Clearly, there is no such motivation. The requirement that there must be a particular suggestion or motivation, found within the prior art itself, prevents an otherwise laudable invention from being dismissed through the application of hindsight reconstruction.

Applicants suggest that the Examiner has failed to identify sufficient motivation or suggestion in the cited references that would lead an artisan of ordinary skill, who was unaware of Applicants' disclosure, to combine a lithophane panel and a toy figure. Applicants therefore suggest that the Examiner has failed to establish the *prima facie* obviousness of claim 1, and therefore dependent claims 2-6.

However, in the interest of further differentiating the claimed invention from the cited references, Applicants have amended claim 1 to incorporate the subject matter originally found in claim 4. As amended, claim 1 now recites a toy set including a toy figure depicting a character, and a lithophane panel depicting an image, where the toy set is packaged so that both the toy figure and the lithophane panel are visible, and image depicted by the lithophane may be viewed when backlit. Applicants suggest that neither Goldfarb et al. nor Dods '777 disclose or suggest the combination of a toy figure and a lithophane panel within packaging that permits viewing of the lithophane image, as recited in claim 1 as amended.

In view of the amendments and remarks above, Applicants respectfully request the withdrawal of the rejection of claims 1-4 under 35 U.S.C. § 103(a).

Claims 5-8 and 12-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods (U.S. Patent no. 6,152,298; hereafter Dods '298), Lapides (U.S. Patent no. 3,173,540) and

Goldfarb.

Dods '298 discloses a system of display packaging suited for the display of trading cards, typically in combination with a model. There is no disclosure in Dods '298 that suggests that it would be desirable to include a lithophane panel within the packaging with a model and trading card. Furthermore, Goldfarb et al. fails to provide a suggestion or motivation to combine a lithophane with a packaging system for trading cards and models, and teaches instead the manufacture of apparatus which may be readily filled with translucent material to produce a lithophane effect. As discussed above, these apparatus are not lithophane panels. Applicants suggest that neither Dods '298 nor Goldfarb et al. provide a suggestion or motivation to combine a lithophane panel with display packing and a toy.

The Examiner suggests it would have been obvious to one of ordinary skill in the art from the teaching of Lapides to include an aperture in the backing sheet of Dods '298 in order to not hinder a potential purchaser's view of the item while still in the packaging, and in order to create an image of extreme beauty and delicacy so as to be pleasing to an observer. Applicants respectfully disagree.

As discussed above, Applicants suggest that a recitation of the aesthetic properties of a lithophane panel when considered alone necessarily fails to provide an incentive to combine the lithophane panel with a toy or toy figure, and that there is no specific suggestion or motivation in either Dods '298 or Goldfarb et al. to make the combination suggested by the Examiner.

Although Lapides teaches a type of packaging that permits the packaged article to be viewed, Applicants suggest that Lapides also fails to provide a suggestion to combine a lithophane panel with a toy, where the toy and the lithophane panel are associated with the backing sheet, and the lithophane panel is viewable through an aperture in the backing sheet. The

Examiner suggests that packaging for an object having a backing sheet with an aperture is demonstrably old in the display packaging art. However, obviousness under 35 U.S.C. § 103 is not properly determined by evaluating the obviousness of a particular selected feature. Rather, it is the claimed invention *as a whole* that must be considered when determining obviousness (MPEP § 2141.02).

Applicants suggest that the Examiner has failed to provide a specific teaching or suggestion to combine a toy and lithophane panel in a packaged toy. In the absence of such a teaching or suggestion, Applicants suggest that claim 5 is unobvious over the cited references, and that the rejection of claim 5 under 35 U.S.C. § 103(a) should be withdrawn. As claims 6-8 and 12-16 depend directly or indirectly from claim 5, Applicants suggest that they are similarly unobvious.

Claims 9-10 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods '298, Lapides, and Goldfarb as applied above, and further in view of Dods '777. Applicants disagree.

As discussed above, Applicants suggest that even in combination, Dods '298, Lapides, and Goldfarb et al. fail to render the subject matter of claim 5 obvious. For similar reasons, Applicants suggest that the cited references fail to render the subject matter of independent claim 18 obvious.

The further combination of Dods '777 similarly fails to render the claimed subject matter obvious, as Dods '777 fails to disclose lithophane panels or to suggest the combination of a lithophane panel with a toy or toy figure. The Examiner suggests that it would have been obvious to one of ordinary skill in the art from the teaching of Dods '777 to have the toy and panel image

representative of a character figure in order to create an interesting comic collectable. Applicants suggest that Dods '777 is directed to the combination of a figurine and a model book or magazine. It is the combination of the figurine and a related book or magazine that produces a display that would be considered desirable and collectable. There is no suggestion in Dods '777 that the addition of a lithophane panel to the display would be desirable, and no suggestion in the additional cited references that the combination of a toy figurine with a lithophane panel would be desirable. Furthermore, Applicants suggest that as the backing sheet of Dods '777 corresponds to the model book or magazine, and that Dods '777 teaches away from forming an aperture in the backing, as it would detract from the authenticity of the model image.

In view of the above remarks, Applicants suggest that the subject matter of claims 9-10 and 18-20 is unobvious over the cited references, and request that the rejection of the claims under 35 U.S.C. § 103(a) be withdrawn.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods '298, Lapides and Goldfarb. The Examiner suggests that would have been obvious to one of ordinary skill in the art to multiply the number of toys and panels, since such a modification would have involved a mere duplication of parts. As discussed above, the combination of Dods '298, Lapides and Goldfarb fails to render the subject matter of claim 5 obvious under 35 U.S.C. § 103. Applicants therefore suggest that the subject matter of dependent claim 11 is also not obvious in view of the same combination of references. Applicants therefore respectfully request the withdrawal of the rejection of claim 11 under 35 U.S.C. § 103(a).

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods '298,

Lapides, Goldfarb, and Mickelberg (U.S. Patent no. 5,289,916). The Examiner suggests that although the reference does not expressly teach an indication that a panel is viewable when backlit, it teaches providing instructions to a potential consumer on the packaging. As discussed above, the combination of Dods '298, Lapides and Goldfarb fails to render the subject matter of claim 5 obvious under 35 U.S.C. § 103. Applicants suggest that the further addition of Mickelberg fails to overcome the deficiencies in the previously cited references in rendering the subject matter of claim 5 obvious, particularly as the apertures in the packaging of Mickelberg serve to reveal a substantially non-translucent toy that is quite distinct from a lithophane panel. As claim 5 is not obvious in view of the cited references, Applicants suggest that dependent claim 17 is similarly not obvious in view of the cited references, and request the withdrawal of the rejection of claim 17 under 35 U.S.C. § 103.

Applicants believe that the instant application is in condition for allowance. However, if the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

CERTIFICATE OF MAILING

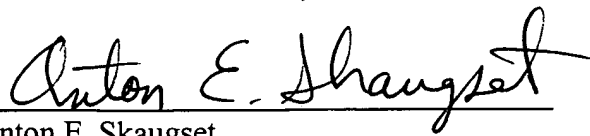
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on November 14, 2006.



Suzanne Lukas-Werner

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Anton E. Skaugset
Registration No. 38,617
Customer No. 23581
Attorney/Agent for Applicant(s)/Assignee
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679